

REMARKS

Applicant appreciates the careful examination given to the Application as reflected in the Office Action mailed March 7, 2005. Reconsideration and favorable action in this Application is respectfully requested.

Claims 1-45 remain pending in this Application; claims 5, 6 and 16-41 are withdrawn from consideration and claims 1-4, 7-15 and 42-45 stand rejected.

Claims 1-4, 7-8, 15 and 42 has been amended to claim patentable subject matter.

Claims 5, 6 and 16-41 have been cancelled.

Claims 46, 47 and 48 have been added for which there is support in the specification.

§102 (b) Rejection of Claims

Applicant has amended claim 42 to claim patentable subject matter. The Office Action rejects claim 42 under 35 U.S.C. §102(b) as being anticipated by *Sekula*. Anticipation requires that a single piece of prior art disclose each and every element of the claimed invention as arranged in the claim. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1983); *see, In re Paulson*, 30 F.3d 1475, 31 U.S.P.Q.2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990). For anticipation, there must be *no difference* between the claimed invention and the referenced disclosure. (Emphasis added.) *Scripps Clinic and Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). Claim 42 has been amended to add the additional limitation that the corrugated substrate is substantially rigid. Since *Sekula* does not disclose a rigid corrugated substrate as in Applicant's amended claim 42, *Sekula* cannot anticipate claim 42 under §102(b). Therefore claim 42 is patentable over *Sekula*.

With respect to claim 43, Applicant argues that this claim is patentable and not anticipated by *Sekula*. Since claim 42 has been amended to include patentable subject matter and claim 43 depends from claim 42, claim 43 is also patentable because it adds additional limitations to an allowable claim. Therefore claim 43 is not anticipated by *Sekula* and is patentable.

§103(a) Rejection of Claims

Applicant has amended claim 1 to claim patentable subject matter. The Office Action rejects claim 1 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* (Italian Patent 590, 156) in view of *Patel et al.* Claim 1 is amended to add the limitations that the release layers are completely bisected in a straight line along an axis parallel to the length of the strip and each of the release layers and that the transfer sheet and the release layers must be of different types of materials. Claim 1 has been further amended to eliminate the element that the first and second adhesive surfaces are water soluble as disclosed in *Patel et al.*¹ *Avery Adhesive* or *Patel et al.* do not disclose or teach these additional limitations nor would it have been obvious to one of ordinary skill in the art to add these limitations. Therefore the Office Action does not establish a prima facie case of obviousness of claim 1 as amended. See, *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). Claim 1 is patentable and not obvious in light of *Avery Adhesive* in view of *Patel et al.*

Applicant has amended claim 3 to claim patentable subject matter. Claim 3 is dependent on claim 1; therefore the amendments discussed above in reference to claim 1 also apply to claim 3. Claim 3 has been amended to add the limitation that the strips are separated by a side margin

¹ Although Applicant has deleted the requirement that the first and second adhesive surfaces are water soluble, Applicant traverses the Office Action's argument that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any conventional double sided adhesive tape such as that disclosed in *Patel et al.* dependent on the desired use of the tape and respectfully requests proof thereof.

indicator of a different character than the bisected release layers. *Avery Adhesive* or *Patel et al.* do not disclose or teach this additional limitation nor would it have been obvious to one of ordinary skill in the art to add this limitation. Therefore the Office Action does not establish a prima facie case of obviousness of claim 3 as amended. *See, In re Oetiker*, 977 F.2d 1443. Claim 3 is patentable and not obvious in light of *Avery Adhesive* in view of *Patel et al.*

Applicant has amended claim 2 to claim patentable subject matter. Claim 2 is dependent on claim 1; therefore the amendments discussed above in reference to claim 1 also apply to claim 2. Applicant traverses the Office Action's argument that it would have been obvious to one of ordinary skill in the art that spaced individual adhesive strips could be more easily removed by hand because the Office Action fails to provide Applicant with support for this statement. *See, In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Claim 2 has further been amended to disclose that the widths of the gaps are of sufficient width to be removed without bending the transfer sheet. The references of *Avery Adhesive*, *Patel et al.* or *Sato* do not disclose or teach this additional limitation nor would it have been obvious to one of ordinary skill in the art to disclose gaps of sufficient width to allow the individual strips to be removed without bending the transfer sheet as required by Applicant's amended claim 2. Therefore the Office Action cannot establish a prima facie case of obviousness of claim 2 as amended. *See, In re Oetiker*, 977 F.2d 1443. Claim 2 is patentable and not obvious in light of *Avery Adhesive* in view of *Patel et al.* further in view of *Sato*.

Applicant has amended claim 4 to claim patentable subject matter. The Office Action rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Patel et al.* and further in view of *Anhauser et al.* Claim 4 is dependent on claim 1; therefore the amendments discussed above in reference to claim 1 also apply to claim 4. Applicant traverses

the Office Action's argument that it would have been obvious to one of ordinary skill in the art to add a lengthwise slit in the cover layer of the references as combined because *Anhauser et al.* teaches the value of such slit for separating and peeling a backing adhesive layer to aid in the removal of two pieces *not* a slit in the cover layer as disclosed in the original claim 4. Claim 4 has been amended to include the limitation that the transfer sheet is rigid. *Avery Adhesive* in view of *Patel et al.* and further in view of *Anhauser et al.* do not disclose or teach this additional limitation nor would it have been obvious to one of ordinary skill in the art to include a rigid transfer sheet as required by Applicant's amended claim 4. Therefore the Office Action cannot establish a prima facie case of obviousness of claim 4 as amended. See, *In re Oetiker*, 977 F.2d 1443. Claim 4 is patentable and not obvious in light of *Avery Adhesive* in view of *Patel et al.* and further in view of *Anhauser et al.*

Applicant has amended claim 7 to claim patentable subject matter. The Office Action rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* The Office Action further rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in light of *Anhauser et al.* Applicant traverses the Office Action's argument that it would have been obvious to one of ordinary skill in the art to add a lengthwise slit in the cover layer of the references as combined because *Anhauser et al.* teaches the value of such slit for separating and peeling a backing adhesive layer to aid in the removal of two pieces *not* a slit in the cover layer as disclosed in the original claim 7. Claim 7 has been amended to include the limitations that the release layer is substantially less rigid than the transfer sheet and that the cut between the release layers is sufficient to allow removal of the portions without bending the transfer sheet. Claim 7 has further been amended to add the limitation that the release layer portions without bending the transfer sheet. *Avery Adhesive* in view of *Anhauser et*

al. and *Sekula* in light of *Anhauser et al.* do not disclose or teach these additional limitations nor would it have been obvious to one of ordinary skill in the art to include these limitations as required by Applicant's amended claim 7. Therefore the Office Action cannot establish a prima facie case of obviousness of claim 7 as amended. See, *In re Oetiker*, 977 F.2d 1443. Claim 7 is patentable and not obvious in light of *Avery Adhesive* in view of *Anhauser et al.* and *Sekula* in view of *Anhauser et al.*

Applicant has amended claim 8 to claim patentable subject matter. The Office Action rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* as applied to claim 7 and in further view of *Sato*. Claim 8 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 8. Applicant traverses the Office Action's argument that it would have been obvious to one of ordinary skill in the art that spaced individual adhesive strips could be more easily removed by hand because the Office Action fails to provide Applicant with support for this statement. See, *In re Zurko*, 258 F.3d 1379. Claim 8 has been amended to include the limitation that the widths of the gaps are greater than about 10% of the widths of each of the plurality of strips. Since *Avery Adhesive*, *Anhauser et al.* and *Sato* do not disclose or teach this limitation nor would it have been obvious to one of ordinary skill in the art to disclose this limitation, claim 8 is patentable and not obvious in light of this prior art. See, *In re Oetiker*, 977 F.2d 1443.

Claim 9 claims patentable subject matter. The Office Action rejects claim 9 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* Claim 9 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 9. Since the cited references do not establish a prima facie case of obviousness of claim 7 and claim 9 depends on claim 7, claim 9 is not obvious because it adds

additional limitations to an allowable claim. *See, In re Oetiker*, 977 F.2d 1443. Therefore claim 9 is patentable and not obvious in light of *Avery Adhesive* in view of *Anhauser et al.*

Claim 10 claims patentable subject matter. The Office Action rejects claim 10 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* and further in view of *Patel et al.* Claim 10 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 10. Since the cited references do not establish a prima facie case of obviousness of claim 7 and claim 10 depends on claim 7, claim 10 is not obvious because it adds additional limitations to an allowable claim. *See, In re Oetiker*, 977 F.2d 1443. Therefore claim 10 is patentable and not obvious in light of *Avery Adhesive* in view of *Anhauser et al.* and further in view of *Patel et al.*

Claim 11 claims patentable subject matter. The Office Action rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* The Office Action further rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in light of *Anhauser et al.* Claim 11 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 11. Since the cited references do not establish a prima facie case of obviousness of claim 7 and claim 11 depends on claim 7, claim 11 is not obvious because it adds additional limitations to an allowable claim. *See, In re Oetiker*, 977 F.2d 1443. Therefore claim 11 is patentable and not obvious in light of *Avery Adhesive* in view of *Anhauser* and *Sekula* in view of *Anhauser et al.*

Claim 12 claims patentable subject matter. The Office Action rejects claim 12 under 35 U.S.C. §103(b) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* Claim 12 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 12. Since the cited references do not establish a prima facie case of

obviousness of claim 7 and claim 12 depends on claim 7, claim 12 is not obvious because it adds additional limitations to an allowable claim. *See, In re Oetiker*, 977 F.2d 1443. Therefore claim 12 is patentable and not obvious in light of *Avery Adhesive* in view of *Anhauser*.

Claim 13 claims patentable subject matter. The Office Action rejects claim 13 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser et al.* The Office Action further rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in light of *Anhauser et al.* Claim 13 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 13. Since the cited references do not establish a prima facie case of obviousness of claim 7 and claim 13 depends on claim 7, claim 13 is not obvious because it adds additional limitations to an allowable claim. *See, In re Oetiker*, 977 F.2d 1443. Applicant also traverses the Office Action's argument that adhesive strips are typically transparent because the Office Action fails to provide Applicant with support for this statement. *See, In re Zurko*, 258 F.3d 1379. Therefore claim 13 is patentable and not obvious in light of *Avery Adhesive* in view of *Anhauser* and *Sekula* in view of *Anhauser et al.*

Claim 14 claims patentable subject matter. The Office Action rejects claim 14 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in light of *Anhauser et al.* Claim 14 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 14. Since the cited references do not establish a prima facie case of obviousness of claim 7 and claim 14 depends on claim 7, claim 14 is not obvious because it adds additional limitations to an allowable claim. *See, In re Oetiker*, 977 F.2d 1443. Therefore claim 14 is patentable and not obvious in light of and *Sekula* in view of *Anhauser et al.*

Applicant has amended claim 15 to claim patentable subject matter. The Office Action rejects claim 15 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view

Sekula in light of *Anhauser et al.* Claim 15 is dependent on claim 7; therefore the amendments discussed above in reference to claim 7 must also apply to claim 15. Claim 15 has also been amended to add the limitation that the width of the strip is substantially less than the width of the transfer sheet. *Avery Adhesive, Sekula* or *Anhauser et al.* do not disclose or teach this additional limitation nor would it have been obvious to one of ordinary skill in the art to include this limitation. Therefore the Office Action cannot establish a prima facie case of obviousness of claim 15 as amended. See, *In re Oetiker*, 977 F.2d 1443. Claim 15 is patentable and not obvious in light of and *Sekula* in view of *Anhauser et al.*

Claim 44 claims patentable subject matter. The Office Action rejects claim 44 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in light of *Anhauser et al.* Since the cited references do not establish a prima facie case of obviousness of claim 42 and claim 44 depends on claim 42, claim 44 is not obvious because it adds additional limitations to an allowable claim. See, *In re Oetiker*, 977 F.2d 1443. Applicant traverses the Office Action's argument that it would have been obvious to one of ordinary skill in the art to use a colored substrate since colored and printed substrates are commonly used for identification and advertising purposes because the Office Action fails to provide Applicant with support for this statement. See, *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Applicant further points out that advertising in a potted plant would not be terribly effective and further would create a visual nuisance. In fact, Applicant discloses the colored substrate is used so it blends with soil so as not to be a visual nuisance. Therefore claim 44 is patentable and not obvious in light of and *Sekula* in view of *Anhauser et al.*

Claim 45 claims patentable subject matter. The Office Action rejects claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in light of *Anhauser et al.* Since the cited

references do not establish a prima facie case of obviousness of claim 42 and claim 45 depends on claim 42, claim 45 is not obvious because it adds additional limitations to an allowable claim. See, *In re Oetiker*, 977 F.2d 1443. Therefore claim 45 is patentable and not obvious in light of and *Sekula* in view of *Anhauser et al.*

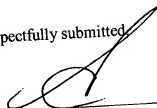
Conclusion

In view of the above, it is submitted that claims 1-4, 7-15 and 42-47 are in condition for allowance because the claims have been amended to include patentable subject matter. Three new claims have been added, 46, 47 and 48, which are believed to be allowable over the art.

Applicant respectfully requests reconsideration of the Application and earnestly solicits allowance. Should it facilitate allowance of the Application, the Examiner is invited to telephone the undersigned attorney.

Dated: August 8, 2005

Respectfully submitted,



George R. Schultz
Reg. No. 35,674
SCHULTZ & ASSOCIATES, P.C.
One Lincoln Centre
5400 LBJ Freeway, Suite 1200
Dallas, Texas 75240
(214) 210-5940 telephone
(214) 210-5941 facsimile